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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/818,520

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FAROUHAR

J

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IM62/1022

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EXAMINER

YAO, S

ART UNIT

PAPER NUMBER

1733

DATE MAILED:

10/22/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/818,520

Applicant(s)

Farquhar et al

Examiner

Sam Chuan Yao

Group Art Unit

1733



☒ Responsive to communication(s) filed on Sep 7, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-23 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-6 is/are allowed.

☒ Claim(s) 7-23 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: “first package half”, “U-shape edge”, and “second package half”.

It is suggested to amend the specification to provide proper antecedent basis on the claimed terminologies.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference number for energy director element 22 is missing from the figures. In addition, reference numbers 23 and 30 shown in figure 4 are not disclosed in the specification. Correction is required.

3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 09-07-99 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not provide sufficient support for an energy director 22 being in a form of groove as illustrated in the figure.

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Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 7-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 7-8, the recitation of a finger in these claims raises an issue of New Matter. The original disclosure teaches providing metal covers having a plurality of fingers, but there is no suggestion in the original disclosure of using a finger for the cover. Moreover, requiring the finger[s] to extend from one of the sides instead of both sides also raises an issue of New Matter.

In claims 9 and 16, the recitation of having fingers from at least two sides also raises an issue of New Matter. These claim read on having fingers on four sides of the metallic cover.

In claim 11, the claim recitation of “with a finger extending from one of the said sides of each cover” raises an issue of New Matter for the same reasons set forth above.

In claim 15, this claim raises an issue of New Matter for the same reason as claim 7.

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In claim 18, the claim recitation of "U-shape" raises an issue of New Matter. The original disclosure fails to teach providing metal covers having an edge forming a U-shape. It is suggested for Applicant to cite a passage or passages to provide support on the newly claimed subject matter. It is interesting to note that as clearly shown in figure 4, the edge portion of the metal covers are bent toward the base of the metal covers. This figure clearly shows that the edge portion of the metal cover does not form a U-shape edge as now claimed (see the fingers). Moreover, broadening the claim by not requiring the metal cover to include fingers extending from each side of the cover also raises an issue of New Matter.

In claims 19 and 21, the claims recitation of "a plane bisecting the U-shaped edge ..." raise an issue of New Matter. The original disclosure fails to teach the presently claimed subject matter. It is suggested for Applicant to cite passage or passages which provide support to the presently claimed subject matter.

In claims 22-23, the claims recitation of "a finger extends ... the frame element is injection molded partially around the edge" (emphasis added) raise an issue of New Matter. The original disclosure fails to teach the presently claimed subject matter. It is suggested for Applicant to cite passage or passages which provide support to the presently claimed subject matter.

6. Claim rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The limitations of: the cover including fingers to each side, and the fingers being embedded into an injected molded plastic frame are critical or essential to the practice of the

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invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

a) while being enabling for covers secured to the frame elements by fingers embedded in the frame elements through injection molding, does not reasonably provide enablement for securing a finger to the frame element as recited in claim 7. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. The specification only discloses covers and frame elements secured together by fingers embedded in the frame elements by injection molding. It is noted that Applicant, on Paper No. 6 dated 08-08-94 in S.N. 08/092,012 (the parent of this reissue application), argues that the "... the chief advantages of the present invention is that it facilitates the bonding of two dissimilar materials, plastic and metal. ... uses a unique injection molding ... The technique includes the use of protruding metallic fingers on the cover ... are embedded in the plastic frame itself. The present invention accomplishes this by means of the multiple fingers 26 ... injection molding is used to provide a plastic frame 16 and 18 that envelope the fingers." (emphasis added). Since the fingers and the injection molding of the frame elements are critical or essential to the practice of the invention (as evidence from Applicant's argument and the original disclosure taken as a whole), but not included in this claim (fingers), this claim is not enabled by the disclosure.

b) while being enabling for covers secured to the frame elements by fingers embedded in the frame elements through injection molding, does not reasonably provide enablement for

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securing an edge (without the recitation of fingers) extending from each of the covers to the frame element as recited in claim 11. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims for essentially the same reason as above.

c) while being enabling for covers secured to the frame elements by fingers embedded in the frame elements through injection molding, does not reasonably provide enablement for securing a U-shape edge extending from each of the covers and one of the frame elements is injection molded, while the other is molded. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims for substantially the same reason as above.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 18-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 is indefinite because the term "U-shaped edge" is not understood. Which portion of the metallic cover is taken to be the "U-shaped edge" of the cover?

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Claim 19 recitation of "... A plane bisecting the U-shaped edge at its terminal portion on a first side and a second side ..." is not understood.

Claim 21 recitation of "... a plane bisecting the U-shaped edge at its terminal portion on a first side and a second side ..." is not understood. Moreover, the limitation of "a plastic perimeter surface exposed and recessed below the plane of the second package half" is also not understood. Is the "recessed below the plane" referring to element number 24 shown in figure 2?

Reissue Applications

9. This reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

10. Claims 7-23 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

In an examiner's amendment in S.N. 08/092,102 (the parent of this reissue application), a limitation requiring "each cover having a first side and a second side with a plurality of fingers

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extending from said sides and wherein edges of the metal covers are bent to conform to the shape of the frame and said fingers are embedded in” (emphasis added) included to claim 1 to place the application in condition for allowance. In addition, in amendment B in Paper No. 6 dated 08-08-99, in response to Examiner’s office action, Applicant amended the claim to include “the plastic frame elements being injection molded around a plurality of fingers” (emphasis added), and then argues on pages 3-4 the criticality of injection molding and “protruding metallic fingers” to the invention. These claims do not, however, include the above limitations, and as such are an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based.

11. The amendment is objected because it fails to provide an explanation of the support in the disclosure for each amendment (non-editorial) with comments on pages separate from pages containing amendments as required by 37 C.F.R. 1.121(b)(2)(iii).

Response to Arguments

12. Applicant's arguments filed on 09-07-99 have been fully considered but they are not persuasive.

In response to Applicant’s argument on page 3 to page 4 paragraph 1 regarding the recapture rule, as correctly noted by Applicant on the bottom of page 3, the previous Examiner added in an Examiner’s Amendment “each cover ...with a plurality of fingers extending ... wherein

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edges of the metal covers are bent to conform to the shape of the frame and said fingers are embedded in” (emphasis added) to place the application in condition for allowance. Note that in the Examiner’s amendment, it requires “fingers” as opposed to “finger”. Equally important, in Paper No. 6 dated 08-08-99, in response to Examiner’s office action, Applicant replaced claim 1 with claim 16 to include “the plastic frame elements being injection molded around a plurality of fingers” (emphasis added), and then argues on pages 3-4 the criticality of injection molding and “protruding metallic fingers” (emphasis added) to the invention. Therefore, it is submitted that removing these limitations constitutes an improper recapture of claimed subject matter deliberately cancelled in the application for the patent upon which the present reissue is based.

In response to Applicant’s arguments on page 4 paragraph 2 to page 9 paragraph 1, it is submitted that a test which the court effectively uses, for determining whether or not a newly recited limitation is new matter is the sufficiency of support in the original disclosure. The question that must be answered is *“whether the disclosure of the application relied upon reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter”*, In re Ralston 227 USPQ 177. Here, it is quite clear that Applicant did not have possession at that time of the later claimed subject matter for reasons set forth in the above rejection.

It is noted that on the bottom of page 14 to paragraph 2 on page 15, Applicant cited passages for support to the newly claimed subject matters. However, the cited passages failed to provide sufficient support to the newly claimed subejct matter. For instant, Applicant cited

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original claims 1-6 and col. 2 line 57 to col. 3 line 61 for support to claims 7-10. It is submitted that, none of these passages remotely suggest a PCB package comprising covers having a finger extending from one of the sides of each cover. In fact, the whole disclosure teaches covers having fingers extending from the sides of each cover; see column 3 lines 25-36, claim 1, figure 3, for example.

In response to Applicant's arguments on the bottom of page 9 to page 10 regarding enablement, Applicant's attention is referred to, for example, *The Gentry Gallery Inc. v. The Berkline Corp.* (CAFC) 45 USPQ2d 1498.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Sam Chuan Yao** whose telephone number is (703) 308-4788. The examiner can normally be reached on Monday-Thursday from 8:00 AM-5:30 PM. The examiner can also be reached on alternate Fridays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mike Ball, can be reached on (703) 308-2058. The **fax number** in Group Art Unit 1733 for any official papers (i.e. papers that will be entered as part of the file wrapper) is (703) 305-7718 and for unofficial papers (e.g. proposed amendments) is (703) 305-7115.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.


Sam Chuan Yao
Primary Examiner
Art Unit 1733

scy
October 21, 1999